REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1-9, 15 and 16 have been amended. Claims 22-24 have been added. Claims 1-24 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims, as for example in connection with the discussion of Figs. 1, 3b, 31-3q, 4, 6 and 7a-7d. No new matter has been entered.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

The Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,625,581 ("Perkowski").

As amended, claim 1 recites:

1.   A method performed by a computer system, comprising:
        storing an electronic version of a paper, wherein the electronic version is displayable on a display device as a likeness of a hardcopy version of the paper; and
        in response to content of a portion of the likeness, forming a hyperlink reference and embedding it within the electronic version, wherein the hyperlink reference is associated with an operation of the computer system and with the portion of the likeness, such that when the electronic version is displayed on the display device as the likeness of the hardcopy version, the hyperlink reference's associated portion of the likeness is selectable by a user to cause the computer system's performance of the hyperlink reference's associated operation, and wherein the content is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; a phrase; and a reference.

As amended, claim 8 recites:

8.   A system, comprising:
a computing device for:

        storing an electronic version of a paper, wherein the electronic version is
            displayable on a display device as a likeness of a hardcopy version of
            the paper; and

        in response to content of a portion of the likeness, forming a hyperlink
            reference and embedding it within the electronic version, wherein the
            hyperlink reference is associated with an operation of the computing
            device and with the portion of the likeness, such that when the
            electronic version is displayed on the display device as the likeness of
            the hardcopy version, the hyperlink reference's associated portion of
            the likeness is selectable by a user to cause the computing device's
            performance of the hyperlink reference's associated operation, and
            wherein the content is at least one of the following, other than a
            computer network address: an alphanumeric character; a symbol; a
            term; a phrase; and a reference.

As amended, claim 15 recites:

15.   A computer program product, comprising:
a computer program processable by a computer system for causing the computer
system to:

        store an electronic version of a paper, wherein the electronic version is
            displayable on a display device as a likeness of a hardcopy version of
            the paper; and

        in response to content of a portion of the likeness, form a hyperlink reference
            and embed it within the electronic version, wherein the hyperlink
            reference is associated with an operation of the computer system and
            with the portion of the likeness, such that when the electronic version
            is displayed on the display device as the likeness of the hardcopy
            version, the hyperlink reference's associated portion of the likeness is
            selectable by a user to cause the computer system's performance of the
            hyperlink reference's associated operation, and wherein the content is
            at least one of the following, other than a computer network address:
            an alphanumeric character; a symbol; a term; a phrase; and a
            reference; and
an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

        "[t]o anticipate a claim, the reference must teach every
        element of the claim...."

Therefore, to sustain a rejection of claim 1, Perkowski must contain all of the above-

recited elements in claim 1. However, Perkowski fails to teach the combination of elements

in amended claim 1. Accordingly, Perkowski does not support a rejection of amended claim 1 under 35 U.S.C. § 102(e).

In relation to amended claims 8 and 15, Perkowski is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to claim 1, Perkowski is defective in establishing a prima facie case of obviousness. As between Perkowski and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 1. In fact, Perkowski teaches away from it.

For example, Perkowski teaches away from a *computer system* that, *in response to content of a portion of a likeness of a hardcopy version of a paper*, forms a hyperlink reference and embeds it within an electronic version of the paper. Instead, Perkowski teaches that formation and embedding of its "CPIR-enabling Applets" are performed by system administrators, site designers, retailers, wholesalers, manufacturers, advertisers and others.

Perkowski states, "Notably, the creation, distribution and embedding of such CPIR-enabling Applets must be carried out well in advance of the consumer arriving at the particular point of presence shown in FIG. 4T1" (col. 77, lines 20-23). Perkowski teaches that "...CPIR-enabling Applets are *created by the system administrator*, loaded within the UPNIURL database management subsystem thereof, *distributed to retailers, wholesalers, manufacturers, advertisers and others for embedding within HTML-encoded documents...*" (col. 10, lines 38-43)(emphasis added). Accordingly, Perkowski states, "...CPIR-enabling servlet tags are distributed over the Internet and *inserted within HTML*

documents by others than the servlet author, at some future date..." (col. 53, lines 28-31)(emphasis added).

Perkowski describes "...*Applet embedding operations which will typically be carried out alongside of other HTML-code authoring and management operations* involving, for example, the design, construction, management and maintenance of Web-pages, EC-stores, on-line (retail and wholesale) product catalogs, on-line auction site pages, Web advertisements, and the like" (col. 93, lines 59-65)(emphasis added). For example, Perkowski states, "...optional parameters enable the Web page, EC-commerce site and auction *site designer to modify* (after Java class code compiling and loading operations, but before Applet tag insertion/embedding operations) certain *parameters and attributes within each CPIR-enabling Applet tag that determine the precise location where the Java-enabled browser on the client machine 13 will display the CPIR-enabling Applet and its associated image graphics on the browser display screen*" (col. 60, lines 45-53)(emphasis added). Accordingly, Perkowski's "method involves enabling *retailers, wholesalers, advertisers, and others* to (1) open the downloaded servlet tag containing files, (2) extract the CPIR-enabling servlet tags contained therewithin, and (3) *embed (i.e. insert) one or more distributed CPIR-enabled servlets HTML tags into acceptable HTML-encoded documents* associated with EC-enabled WWW sites, EC-enabled storefronts and catalogs, Internet product advertisements, on-line auction-based WWW sites, or other types of Web-documents" (col. 62, lines 46-54)(emphasis added). In doing so, Perkowski teaches that the retailers, wholesalers, advertisers, and others may use "...commercially available HTML-authoring tools which enable quick and easy creation of HTML-encoded documents, and easy insertion of any downloaded CPIR-enabling Applet HTML tag *using, for example, simple commands or drag-and-drop procedures*" (col. 63, lines 2-7)(emphasis added).

Consequently, Perkowski teaches away from a *computer system* that, *in response to content of a portion of a likeness of a hardcopy version of a paper*, forms a hyperlink reference and embeds it within an electronic version of the paper. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to amended claims 8 and 15, Perkowski is likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of amended claims 1, 8 and 15 is not supported.

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Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 2-7 and 22 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 9-14 and 23 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 16-21 and 24 depend from and further limit claim 15 and therefore are allowable.

An early formal notice of allowance of claims 1-24 is requested.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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